

AMENDMENTS TO THE DRAWINGS

The drawings were objected to as failing to comply with 37 CFR 1.84(p)(5). The Examiner stated that the drawings included the following reference sign not mentioned in the description: "46" in Fig. 1. Applicant submits a replacement sheet, which accompany this amendment, replacing reference numeral "46" with numeral "42," which is referred to in the specification in paragraph [0014] at lines 10 and 11.

Attachment: (1) Replacement sheet of drawings.

REMARKS

Applicant has reviewed the detailed Office Action mailed May 04, 2005 and thanks Examiner Patel for his careful review of the pending claims. Claims 1-14 have been rejected. Claims 1, 2, and 10 have been amended. No claims have been canceled or added. Accordingly, claims 1-14 remain pending in this application. Applicant requests reconsideration of the pending claims in view of the above amendments and the following remarks.

Objection to the Drawings

Applicant notes Examiner's objections to the drawings. Applicant has attached a replacement sheet correcting the typographical error in Fig. 1. Accordingly, Fig. 1 now conforms to the specification. Withdrawal of the rejection is respectfully requested.

Objection to the Specification

The Examiner has also objected to the disclosure. However, Fig. 1 has been amended to replace element "46" with element "42". Accordingly, the objection is now moot.

Claim Rejections Under 35 U.S.C. §112

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated that the preamble of claim 2 is inconsistent to what is claimed, questioning how the piston ring assembly can have a ring groove of a piston. The rejection is respectfully traversed.

Claim 2 has been amended to clarify that the claimed piston ring assembly does not require a ring groove. Accordingly, Applicant respectfully requests that the rejection under §112 be withdrawn.

Claim Rejections Under 35 U.S.C. §102

A. Claim Rejections Using Braendel

Claims 1-3, 7 and 9 were rejected under 35 U.S.C §102(b) as being anticipated by Braendel (U.S. Patent No. 3,000,678). Applicant respectfully traverses the rejection.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *See* MPEP §2131. Because there are features in claims 1-3, 7 and 9 that are not taught by Braendel, the rejection must be withdrawn.

More specifically, independent claim 1, as amended, positively requires that the upper ring and the lower ring contact each other. This feature is not shown or taught in Braendel. Indeed, Braendel expressly teaches a compression ring 20 that is spaced apart from a rail ring 22 such that no part of the compression ring 20 is contacting the rail ring 22. Indeed, a spacer ring 24 biases the rings apart. (Column 2, lines 45-55.) Accordingly, as the Braendel reference does not teach every limitation of claim 1, the rejection should be withdrawn.

Claims 2-3, 7 and 9, which each contain additional limitations, are also allowable over the prior art by virtue of their dependency on now allowable claim 1. Withdrawal of the rejection with respect to these claims is requested, as well.

B. Claim Rejections Using Landon

Claims 1-2, 4 and 6 are rejected under 35 U.S.C. §102(b) as being anticipated by Landon (U.S. Patent No. 2,323,815). Applicant respectfully traverses the rejection.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal*

Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Because there are features in claims 1-2, 4 and 6 that are not taught by Landon, the rejection must be withdrawn.

More specifically, and as noted above, independent claim 1, as amended, positively requires that the upper ring and the lower ring contact each other. This feature is not shown or taught in Landon. Indeed, Landon teaches that the upper and lower oil control members 1, 2 are spaced apart from one another by a spacer member 3. The oil control members 1, 2 do not contact each other at any portion, as specifically required by amended claim 1. Accordingly, as the Landon reference does not teach every limitation of claim 1, the rejection should be withdrawn.

Claims 2, 4, and 6, which each contain additional limitations, are also allowable over the prior art by virtue of their dependency on now allowable claim 1. Withdrawal of the rejection with respect to these claims is requested, as well.

Claim Rejections Under 35 U.S.C. §103

A. Claim rejections Using Landon In View of Hellman.

Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Landon in view of Hellman (US. 1,836,027). The Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the upper and lower rings of Landon to have a plurality of projections as taught by Hellman, to provide proper drainage of oil (Column 2, line 59 of Hellman). Applicant respectfully traverses the rejection.

First, the arguments made above with respect to the §102(b) rejection in view of Landon are equally applicable here. Nor does Hellman make up for the deficiencies of Landon.

Second, it is well known that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. *Accord.* M.P.E.P. § 706.02(j). The mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Further, to sustain an obviousness rejection there must be a teaching or suggestion in the prior art to support the combination. However, nothing in Hellman or Landon teaches or suggests combining the references to produce the claimed invention.

Indeed, the Hellman reference teaches a single piston ring having a plurality of oil passages between its inner and outer faces. (Page 2, line 36-38.) Contrarily, Landon teaches a pair of spaced, relatively flat rings or segments. (Page 1, lines 15-16.) The plurality of oil passages taught in Hellman would be structurally incompatible with the Landon reference, which defines the rings as relatively flat. Further, Landon does not teach a piston ring assembly wherein one of the upper and lower rings include a plurality of projections on a mating inner surface to define a plurality of vents. Accordingly, the combination of Landon and Hellman does not obviate the invention. Withdrawal of rejection is respectfully requested.

B. Claim Rejections Using Braendel In View of Landon

Claims 10, 12, and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Braendel in view of Landon. Applicant respectfully traverses the rejection.

Like claim 1, independent claim 10 has been amended to positively recite that the upper ring and the lower ring contact each other. This feature is not shown or taught in

Braendel or Landon. Indeed, both Braendel and Landon expressly away from such a structure. Accordingly, withdrawal of the rejection is respectfully requested.

C. Claim Rejections Using Braendel in view of Hellman

Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over Braendel and Landon as applied to claim 10, and further in view of Hellman. The arguments made above with respect to the §102 and §103 rejections are equally applicable here. Withdrawal is respectfully requested.

C. Claim Rejections Using Landon

Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over Landon. Applicant traverses the rejection. The arguments made above with respect to the §102 rejection is equally applicable here.

D. Claim Rejections Over Braendel, Landon and Hellman

Claim 11 is rejected under 35 U.S.C. §103(a) as being unpatentable over Braendel, Landon, and Hellman. Claim 11 The arguments made above with respect to the §102 and §103 rejections are equally applicable here. Withdrawal is respectfully requested.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1765 from which the undersigned is authorized to draw.

Dated: August 4, 2005

Respectfully submitted,

By 

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